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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-9889

EXAMINER

TORRES, MARCOS L

ART UNIT PAPER NUMBER

2683

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21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/416,526

Applicant(s)

LEHTONEN ET AL.

Examiner

Marcos L Torres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 28-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 28-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-22 and 28-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3, 6, 9-10, 12-14, 18, 20-21, 26-27, 31-32, 34, 37-38, 42-45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Vossler.

As to claims 1 and 32, Sonti discloses a method of configuring communication services for a subscriber within a communication system, comprising the step of: defining a set of profiles for the subscriber, each profile defining a set of communication services from amongst a plurality of communication services (features) available in the communication system (see column 5, line 56 – column 6, line 4); choosing a particular one of said profiles in dependence on a predefined criterion definable by the subscriber (see column 5, lines 32-44); and registering the chosen profile as the profile used to define a current configuration of communication services available to the subscriber, wherein said predefined criterion defines a condition under which said particular one of said set of profiles is to be registered as the profile used to define the current configuration of communication services available to the subscriber (see column 1, lines 57-60; column 8, lines 25-33). Sonti do not specifically disclose choosing a particular one of said profiles automatically. Vossler discloses choosing a particular one of said profiles automatically in dependence on a predefined criterion definable by the subscriber or a service provider of the communication system (see abstract) and registering the chosen profile as the profile used to define a current configuration of communication services available to the subscriber, wherein said predefined criterion defines a condition under which said particular one of said set of profiles is to be

registered as the profile used to define the current configuration of communication services available to the subscriber (see col. 4, lines 3-18). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Vossler teachings with Sonti system for an easier and more reliable system.

As to claims 2 and 3, Sonti discloses a method wherein the said set of profiles is specific to the subscriber and wherein the pre-defined criterion is dependent upon the subscriber (see column 6, lines 7-11).

As to claim 6, Sonti discloses a method wherein a predetermined profile is designated to be registered in the event that none of said profiles meets the pre-defined criterion (see column 5, lines 62-65).

As to claim 9, Sonti discloses a method wherein the set of profiles is stored in a central database of the communication system (see column 5, lines 13-15).

As to claim 10, Sonti discloses that his method wherein the configurations are stored central database is a Home Location Register and anticipated that it could be a different system (see column 5, lines 40-41 and column 9, lines 9-14).

As to claims 12-13, 34 and 42-45, Sonti discloses a method wherein the sensed external parameter is indicative of a time, the predefined criterion is a time and location dependent criterion and the choosing of the configuration of a communication services is performed in dependence on the sensed external parameter meeting the time or location dependent criterion (see column 1, lines 57-60). Sonti do not specifically disclose said choosing is sensed automatically. Vossler discloses choosing a particular one of said profiles automatically in dependence on a predefined criterion definable by

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the subscriber or a service provider of the communication system (see abstract).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Vossler teachings with Sonti system for an easier and more reliable system.

As to claim 14, Sonti discloses a method wherein the predefined criterion is dependent upon the equipment identity of the mobile station (see column 5, line 65 to column 6, line 1).

As to claim 18, Sonti discloses an apparatus, for use in a communication system, comprising a register containing information about a subscriber to the communication system (see column 4, lines 56-65); a register comprising a set of profiles for the subscriber, each profile defining a set of communication services from amongst a plurality of communication services available within communication system (see column 6, lines 31-36); means for choosing a particular one of said profiles in dependence on a predefined criterion definable by the subscriber (see column 5, lines 32-44); and registering the chosen profile as the profile used to define a current configuration of communication services available to the subscriber, wherein said predefined criterion defines a condition under which said particular one of said set of profiles is to be registered as the profile used to define the current configuration of communication services available to the subscriber (see column 1, lines 57-60; column 8, lines 25-33). Sonti do not specifically disclose choosing a particular one of said profiles automatically. Vossler discloses choosing a particular one of said profiles automatically in dependence on a predefined criterion definable by the subscriber of the communication system (see

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abstract) and registering the chosen profile as the profile used to define a current configuration of communication services available to the subscriber, wherein said predefined criterion defines a condition under which said particular one of said set of profiles is to be registered as the profile used to define the current configuration of communication services available to the subscriber (see col. 4, lines 3-18). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Vossler teachings with Sonti system for an easier and more reliable system.

As to claim 20, Sonti discloses an apparatus wherein the said set of profiles is specific to the particular subscriber (see column 2, lines 34-42).

As to claim 21, Sonti discloses an apparatus wherein pre-defined criterion is specific to the particular subscriber (see column 1, lines 56-60).

As to claims 26 and 27, Sonti discloses an apparatus in a communication system comprising: sensing means for sensing at least one external parameter; register means for storing predefined criteria for a mobile station (see col. 8, lines 25-29). Sonti do not specifically disclose processing means for automatically choosing a configuration for the mobile station available within the communication system and related to the mobile station based on the sensed at least one external parameter meeting the predefined criterion. Vossler discloses choosing a particular one of said profiles automatically in dependence on a predefined criterion definable by the subscriber or a service provider of the communication system (see abstract). Therefore, it would have been obvious to

one of the ordinary skill in the art at the time of the invention to combine the Vossler teachings with Sonti system for an easier and more reliable system.

As to claims 31 and 37-38, Sonti discloses the use of a default configuration (see col. 5, lines 62-65). Vossler discloses choosing a particular one of said profiles automatically in dependence on a predefined criterion definable by the subscriber of the communication system (see abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Vossler teachings with Sonti system for an easier and more reliable system.

As to claim 47, Vossler discloses choosing a profile based on a comparison (see abstract). Sonti discloses an apparatus wherein said choosing one of the set of profiles includes comparing an indication of a number called with a number dependent criterion (see col. 8, lines 25-33). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Vossler teachings with Sonti system for a user-friendly system.

6. Claims 4-5, 7-8, 11, 15-17, 19, 23-25, 28-30, 36 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Vossler as applied to claims 1-3, 6, 9-10, 12-14, 18, 20-21, 26-27, 31-32, 34, 37-38, 42-45 and 47 above, and further in view of Buhrmann ('778).

As to claims 4 and 36, Sonti discloses everything claimed as explained above except for a method of checking the choice of registered profile each time a call is made. Buhrmann discloses a method of checking the choice of registered profile each time a call is made (see column 11, lines 9-19). Therefore, it would have been obvious

to one of the ordinary skill in the art at the time of the invention to add these features to the modified Sonti system for a more versatile system.

As to claim 5, Sonti discloses everything claimed as explained above except for a method wherein the set of profiles is ranked in order of priority such that one of relatively higher priority that satisfies the predefined criterion is used before one of relatively lower priority that also satisfies the predefined criterion. Buhrmann discloses a method wherein the set of profiles is ranked in order of priority such that one of relatively higher priority that satisfies the predefined criterion is used before one of relatively lower priority that also satisfies the criterion (see column 8, lines 20-38). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Buhrmann features to the modified Sonti system for the simple purpose of increasing the flexibility of the system.

As to claims 7 and 39, Sonti do not specifically disclose a method wherein the automatic choosing of a profile may be overridden to allow selection or registration of a particular one of said set of profile. However the use of manually override an automatic process is a common and well known technique, for example stopping a voice mail system, silence an incoming call, etc. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the modified Sonti system for more convenience.

As to claims 8, 33 and 40-41, Sonti do not specifically disclose a method wherein selection or registration of a certain profile is not permitted according to a predefined rule. However, denial of a service or features when they are not valid in a predefined

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rule is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the modified Sonti system to minimize errors.

As to claims 11 and 30, Sonti discloses everything claimed as explained above except for the method wherein the predefined criterion is a date-dependent criterion and choosing a particular one of said set of profiles is performed automatically in dependence on said date-dependent criterion. Vossler discloses choosing a particular one of said profiles automatically in dependence on a predefined criterion definable by the subscriber or a service provider of the communication system (see abstract). Buhrmann discloses a method wherein the predefined criterion is dependent upon the date (see column 6, lines 32-42). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine these techniques to further automate the modified Sonti system.

As to claim 15 and 16, Sonti discloses everything claimed as explained above except for the method wherein the predefined criterion is dependent upon the number or type called. 15. Buhrmann discloses a method wherein the predefined criterion is dependent upon the number or type called (see column 8, lines 25-31). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the feature of Buhrmann to the modified system of Sonti for a more versatile system.

As to claim 17, Sonti discloses everything claimed as explained above except for a method wherein a configuration of the communication service is chosen automatically

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according to a plurality of predefined criteria. Buhrmann discloses a method wherein a configuration is chosen according to a plurality of predefined criteria (see column 8, lines 5-19). Vossler discloses choosing a particular one of said profiles automatically in dependence on a predefined criterion definable by the subscriber or a service provider of the communication system (see abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the feature of Buhrmann to the modified system of Sonti for an easier updating system.

As to claim 19, Sonti discloses an apparatus wherein said registers form part of the Home Location Register (HLR). Sonti do not specifically disclose the use of his system in a GSM communication system. However, it would be obvious to one of the ordinary skill in the art at the time of the invention to use the modified Sonti system in an equivalent communication system.

As to claim 23, Sonti discloses everything claimed as explained above except for an apparatus or method wherein the external parameter is a hardware parameter. Buhrmann discloses an apparatus or method wherein the external parameter is a hardware parameter (see column 6, lines 43-59). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add a hardware parameter to the modified Sonti system for more enhanced functions.

As to claim 24, Sonti discloses a communication system comprising: a Mobile Services Switching Center (MSC) (see fig. 1, #34), the MSC including a Home Location Register (HLR) (see col. 5, lines 13-14, fig 1, #74); a base station controller operatively connected to the MSC; a base station operatively connected to the base station

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controller (see fig. 1, #40); and a mobile station operatively connected to the base station (see fig. 1, #30), the mobile station having capability for sensing at least one external parameter, a configuration of communication services for the mobile station being chosen from a plurality of configurations available within the communication system and related to the mobile station based on the sensed external parameter meeting a pre-defined criterion definable at the mobile (see col. 8, lines 25-29). Sonti do not disclose that the configuration is automatically chosen. Vossler discloses choosing a particular one of said profiles automatically in dependence on a predefined criterion definable by the subscriber or a service provider of the communication system (see abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Vossler teachings with Sonti system for an easier and more reliable system.

As to claims 28 and 29, Sonti discloses everything claimed as explained above except for the method wherein the plurality communication services further comprise at least one of speech services, SMS messaging, international calls barred, international calls barred except to home country, data transfer rate, fax services, High Speed Circuit Switched Data (HSCSD), General Packet Radio Services (GPRS), and outgoing calls barred. Sonti discloses the method wherein the plurality of individual service arrangements further comprise at least one of speech services, SMS messaging, international calls barred, international calls barred except to home country, data transfer rate, fax services, High Speed Circuit Switched Data (HSCSD), General Packet Radio Services (GPRS), and outgoing calls barred (see col. 11, lines 34-54). Therefore,

it would have been obvious to one of the ordinary skill in the art at the time of the invention to add these features to the modified Sonti system for enhanced multiple services.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view Vossler as applied to claims 1-3, 6, 9-10, 12-14, 18, 20-21, 26-27, 31-32, 34, 37-38, 42-45 and 47 above, and further in view of Hagar.

As to claim 22, Sonti discloses everything claimed as explained above except for the apparatus wherein the external parameter is an environmental parameter. Hagar discloses an telecommunication apparatus wherein the external parameter is an environmental parameter (see col. 1, lines 5-14). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Hagar teachings to the modified Sonti system for an enhanced multi feature communication system.

8. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view Vossler as applied to claims 1-3, 6, 9-10, 12-14, 18, 20-21, 26-27, 31-32, 34, 37-38, 42-45 and 47 above, and further in view of Ziccker.

As to claim 35, Sonti discloses choosing a particular one of said profiles in dependence on a predefined criterion definable by the subscriber (see column 5, lines 32-44). Sonti does not specifically disclose wherein the subscriber defines at least one configuration of communication services for a user of a mobile station other than the subscriber. Ziccker discloses wherein the subscriber defines at least one configuration of communication services for a user of a mobile station other than the subscriber (see

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col. 3, line 40 – col. 5, line 25). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to control the configurations of several devices for easier and faster programming.

9. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Vossler as applied to claims 1-3, 6, 9-10, 12-14, 18, 20-21, 26-27, 31-32, 34, 37-38, 42-45 and 47 above, and further in view of Irvin.

As to claim 46, Vossler discloses choosing a profile based on a comparison (see abstract). Sonti and Vossler do not specifically disclose an apparatus wherein said choosing one of the set of profiles includes comparing an indication of an equipment identity of a mobile station with an equipment identity-dependent criterion. Irvin discloses an apparatus wherein said choosing one of the set of profiles includes comparing an indication of an equipment identity of a mobile station with an equipment identity-dependent criterion (see abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine these teaching for an improved mobile station with enhanced security.

10. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Vossler as applied to claims 1-3, 6, 9-10, 12-14, 18, 20-21, 26-27, 31-32, 34, 37-38, 42-45 and 47 above, and further in view of Martensson.

As to claim 48, Vossler discloses choosing a profile based on a comparison (see abstract). Sonti and Vossler do not specifically disclose an apparatus wherein said choosing one of the set of profiles includes comparing an indication of a type of call with a call type dependent criterion. Martensson discloses an apparatus wherein said

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choosing one of the set of profiles includes comparing an indication of a type of call with a call type dependent criterion (see col. 1, line 62 – col. 2, line 2). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine these teaching for the simple purpose of enhanced convenience.

11. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Irvin.

As to claim 49, Sonti discloses a method of configuring services for a subscriber within a communication system, comprising the step of: reading an external parameter (see column 8, lines 25-29); choosing for the particular subscriber, a configuration of communication services from a plurality of configurations in the communication system (see column 5, lines 32-44); and using the chosen configuration to define a current configuration of communication services available to the subscriber, wherein said choosing of a configuration of communication services is performed in dependence on the sensed external parameter meeting a pre-defined criterion (see column 1, lines 57-60). Sonti do not specifically disclose determining if the sensed external parameter relates to a forbidden configuration of the communication services and choosing for the particular subscriber, a configuration of communication service. Irvin discloses determining if the sensed external parameter relates to a forbidden configuration of the communication services and choosing for the particular subscriber, a configuration of communication service (see abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Irvin teachings with Sonti system for a secure and more reliable system.

Conclusion

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For formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Crystal Park II
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcos L Torres
Examiner
Art Unit 2683

Mlt



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600